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| 10/788,677 | 02/27/2004 | Michael D. Smith | 418268004US | 3591 |

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| EXAMINER |
|---|
| EVANS, KIMBERLY L |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>29 March 2010</u>.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1,2,5,7-11,22,23 and 25-29</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,2,5,7-11,22,23 and 25-29</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a) ☐ All  b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the application filed on March 29, 2010.

2. Claims 1, 5, 22, and 25 have been amended.

3. Claims 3, 4, 6, 12-21 and 24 have been cancelled.

4. Claims 28 and 29 are new claims.

5. Claims 1, 2, 5, 7-11, 22, 23, and 25-29 are currently pending and have been examined.

### Claim Rejections - 35 USC § 112 – 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites "...a computer system......" in the preamble, however, the body of claim 1 is silent with respect to the how the operations of "...acquiring a block of tickets...", "...adding the acquired ticket to the message...", and "...forwarding the message..." will be executed. The dependent claims 2, 5, and 7-11 do not remedy this flaw and therefore are also rejected.

8. Claims 7 and 8 recite the limitation "the recipient's mail system" in the first line of the respective claims. There is insufficient antecedent basis for this limitation in the claims.

## Claim Rejections - 35 USC § 101

9.    The following is a quotation of the first paragraph of 35 U.S.C. 101:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

10.   Claims 1, 22, and 25 are rejected under 35 USC 101 because the method disclosed is directed

toward non-statutory subject matter.   In order for a method to be considered a "process" under

§101, a claimed process must either: (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials).   Diamond

v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v.

Benson, 409 U.S. 63, 70 (1972).   A method claim must meet a specialized, limited meaning to

qualify as a patent-eligible process claim.   A mere field-of-use limitation is generally insufficient to

render an otherwise ineligible method claim patent-eligible.   The machine or transformation must

impose meaningful limits on the method claim's scope to pass the test.   The method steps of

independent claims 1, 22, and 25 are not tied to another statutory class and can be performed

without the use of particular apparatus.   The preamble of Claims 1, 22, and 25 recite "... a

method performed by a computing system...", however, the preamble is not given patentable

weight.   Second, insignificant extra-solution activity will not transform an unpatentable principle

into a patentable process.   This means, reciting a specific machine or a particular transformation

of a specific article in an insignificant step such as data gathering or outputting, is not sufficient to

pass the test.   If neither of these requirements is met by the claim(s), the method is not a patent

eligible process under §101 and is non-statutory subject matter.   The respective dependent

claims 2, 5, 7-11, 23, and 26-29 do not remedy this flaw, and are also rejected.

### Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b),
by another filed in the United States before the invention by the applicant for patent or (2) a
patent granted on an application for patent by another filed in the United States before the
invention by the applicant for patent, except that an international application filed under the treaty
defined in section 351(a) shall have the effects for purposes of this subsection of an application
filed in the United States only if the international application designated the United States and
was published under Article 21(2) of such treaty in the English language.

12. Claims 22, 23, and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Burrows et

al., US Patent Application No US 2004/0093371 A1.

13. The applied reference has a common assignee with the instant application. Based upon the

earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR

1.132 that any invention disclosed but not claimed in the reference was derived from the inventor

of this application and is thus not the invention "by another," or by an appropriate showing under

37 CFR 1.131.

14. With respect to Claims 22 and 25,

Burrows discloses the following limitations,

- *receiving an electronic message having a ticket issued by a ticketing entity, the ticket having*
  *a value that is specified by a sender;* (see at least paragraph 35: "…A ticket may be
  implemented as a small binary value (e.g., in the range of about 500 bits), typically
  represented as a base-64 string so that it can readily be shipped through web pages, URLs,
  or e-mail messages.….")

- *presenting the electronic message to a recipient; when the recipient indicates to redeem the*
  *ticket, submitting the ticket to the ticketing entity for redemption wherein the ticketing entity*
  *charges the sender for a value of the ticket; and* (see at least paragraph 13: "…If an e-mail

message does not have an electronic postage stamp, it will not be allowed into the recipient's mailbox...")

- *when the recipient does not indicate to redeem the ticket, suppressing the redeeming of the ticket so that a recipient can conditionally redeem tickets*(see at least paragraph 35: "...a request for a new ticket will result in a "challenge" from the Ticket Server; the correct response to this challenge will provide the requestor with the desired ticket. Tickets might have various values, or might be restricted to particular uses. When a ticket has been issued, it can be passed around (for example, with some request or attached to some e-mail). The recipient of a ticket can call the Ticket Server to verify and cancel the ticket, thereby making the originator pay for the request. The recipient can also credit the ticket back to the originator, making the request free......")

- *wherein a sender's account and a recipient's account are maintained by the same entity*

- *wherein a sender's account and a recipient's account are maintained by different entities*
  (see at least paragraph 23: "...An object of embodiments of the present invention is to provide a system and method for automatically accessing all the e-mail accounts of a particular user no matter where hosted.. ...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the personal email system and method of Huang because it is an efficient way for automatically adjusting the protocols based on a particular provider sites.

15. With respect to Claim 23,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein the redemption includes decreasing an account balance of the sender and increasing an account balance of the recipient* (see at least paragraph 229: "...whoever receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP, discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator

by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket
Server to credit the ticket to the original requestor's account...")

16. With respect to Claim 26,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein the entity that maintains the sender's account transfers the value to the entity that*
  *maintains the recipient's account.* (see at least paragraph 229: "...Finally, whoever receives
  the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP,
  discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator
  by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket
  Server to credit the ticket to the original requestor's account. Requestors with a positive
  balance in their account can call the "Request Ticket" operation and will be given a new,
  valid, unused, ticket without any need to perform a challenge (and their account can be
  debited). ...").

17. With respect to Claim 27,

Burrows discloses all of the above limitations, Burrows further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting*
  *the message to the recipient* (see at least paragraph 18: "...If a Ticket Kit is issued, the client
  is able to construct a valid ticket from a correct answer to the challenge and the data in the
  Ticket Kit. A challenge is described as possibly including a CPU bound task, a memory
  bound task, a task that can be solved only by a human, or monetary payment....")

18. With respect to Claim 28,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein the redemption includes decreasing an account balance of the sender and*
  *increasing an account balance of the recipient* (see at least paragraph 229: "...whoever

receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP,

discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator

by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket

Server to credit the ticket to the original requestor's account...")

19. With respect to Claim 29,

Burrows discloses all of the above limitations, Burrows further discloses,

- *validating that the ticket can be redeemed before presenting the ticket to the recipient* (see at

   least paragraph 228: "...This operation verifies that the ticket is valid, and that it has not been

   used before. It then marks the ticket as having been used, and returns to the caller (for

   example, the recipient of the e-mail) indicating that the operation succeeded...")

**Claim Rejections - 35 USC § 103**

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or
described as set forth in section 102 of this title, if the differences between the subject
matter sought to be patented and the prior art are such that the subject matter as a whole
would have been obvious at the time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

21. Claims 1, 2, 5, and 7-11, and are rejected under 35 U.S.C. 103(a) as being obvious over Burrows

et al., US Patent Application Publication No US 2004/00093371A1. The applied reference has a

common assignee with the instant application. Based upon the earlier effective U.S. filing date of

the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but

not claimed in the reference was derived from the inventor of this application and is thus not an

invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the

application which corresponds to subject matter disclosed but not claimed in the reference, prior

to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration

under 37 CFR 1.130 stating that the application and reference are currently owned by the same

party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104,

together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also

be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a

rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

22. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),
    that are applied for establishing a background for determining obviousness under 35
    U.S.C. 103(a) are summarized as follows:

    i.      Determining the scope and contents of the prior art.

    ii.     Ascertaining the differences between the prior art and the claims at issue.

    iii.    Resolving the level of ordinary skill in the pertinent art.

    iv.     Considering objective evidence present in the application indicating obviousness or
            nonobviousness.

23. Claims 1, 2, 5, and 7-11, are rejected under 35 USC 103(a) as being unpatentable over Burrows
    in view of Couelgnoux, US Patent Application Publication No US 2006/0053279A1.

24. With respect to Claims 1, and 11,

    Burrows discloses the following limitations,

    • *acquiring a block of tickets at a time from a ticketing entity,* (see at least paragraph 35: "...a
      Ticket Server provides a network service that can issue "tickets" and can verify and cancel
      previously issued tickets...") *the block of tickets including at least one ticket having a value
      specified by a sender of a message* (see at least paragraph 35: "...A ticket may be

implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....") *each ticket of the block including a code from a sequence of codes generated from a start code using a one-way function;* (see at least paragraph 35: "...A ticket may be implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....")

- *wherein the message is an electronic mail message*

- *adding the acquired ticket to the message* (see at least paragraph 13: "...If an e-mail message does not have an electronic postage stamp, it will not be allowed into the recipient's mailbox..."); *and forwarding the message with the added ticket to a recipient,* (see at least paragraph 13: "...by adding an easily detectable and verifiable postage stamp, users would be able to filter out e-mail that does not have this postage stamp..."; paragraph 14: "...When sending a message, the message is handed to a delivery agent that communicates with the mail server at the ISP...")

- *wherein upon receiving the message, the recipient can conditionally, redeem the value of the ticket from the ticketing entity* (see at least paragraph 35: "...a request for a new ticket will result in a "challenge" from the Ticket Server; the correct response to this challenge will provide the requestor with the desired ticket. Tickets might have various values, or might be restricted to particular uses. When a ticket has been issued, it can be passed around (for example, with some request or attached to some e-mail). The recipient of a ticket can call the Ticket Server to verify and cancel the ticket, thereby making the originator pay for the request. The recipient can also credit the ticket back to the originator, making the request free......")

Burrows discloses all of the above limitations, Burrows does not distinctly disclose the following limitations, but Couelgnoux however, as shown discloses,

- *and wherein a mail server is provided with an end code of the sequence of codes and determines whether a ticket of the message includes a code from which the end code can be derived.* (see at least paragraph 27: " ..authorized by the receiver's filter, can secretly compute an authorization code unique to the filter, sender pair that it appends to the message sent to the receiver. The receiver's receiving agent can depend on a third party to compute the authorization code independently and compare it to the one produced by the sender's sending agent. If the comparison fails, the message is not displayed to the receiver as intended by the sender ...."; paragraph 62: "...Domain vocabulary 32 and adhoc vocabulary 33 are lists of codes suitable for helping receiver 2 check the desirability of receiving an email from sender 1...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the method and system of Couelgnoux because the filter process is an efficient means for filtering out undesirable electronic messages.


25. With respect to Claim 2,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the acquired ticket includes a sender authenticating code so that a mail server that receives the message can authenticate the sender of the message.* (see at least paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire tickets charged to A's account...")


26. With respect to Claim 5,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *wherein the tickets are added to messages in reverse order of generation of their codes.* (see at least paragraph 14: "...When sending a message, the message is handed to a delivery

agent that communicates with the mail server at the ISP. Receiving messages is basically the reverse process.....")

27. With respect to Claims 7,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient* (see at least paragraph 18: "...If a Ticket Kit is issued, the client is able to construct a valid ticket from a correct answer to the challenge and the data in the Ticket Kit. A challenge is described as possibly including a CPU bound task, a memory bound task, a task that can be solved only by a human, or monetary payment....")

28. With respect to Claim 8,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the recipient's mail system can automatically discard messages with ticket values below a threshold value set by the recipient.*( see at paragraph 236: "...if a message arrives not from a white list member and without a ticket, or if the sender's address is invalid (so that no bounce message can be sent), or if an invalid or previously cancelled ticket is provided at any stage, then the ISP 30 silently discards the message. The same is true of messages that exist for too long without a ticket being submitted to the ISP. ...")

29. With respect to Claim 9,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *when the recipient redeems the ticket, an account of the sender is debited.* (see at least paragraph 229: "...Requestors with a positive balance in their account can call the "Request Ticket" operation and will be given a new, valid, unused, ticket without any need to perform a challenge (and their account can be debited). ...")

30. With respect to Claim 10,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *when the recipient redeems the ticket, an account of the sender is credited.* (see at least
  paragraph 32: "...the centralized service allows the receiver to indicate that a given e-mail is
  not in fact spam, and so the attached postage should be credited back to the sender.."; 
  paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire
  tickets charged to A's account....")


**Response to Arguments**


31. Applicant's arguments received March 29, 2010 have been fully considered but they are not
    persuasive.  Referring to page 6 of the Remarks, Applicant states that "...Burrows was (and
    continues to be) assigned to the assignee of the instant application at the time of the invention.
    As recognized by the Office Action, Burrows is only a reference - if at all - under 35 U.S.C. §
    102(e). Thus, Burrows is disqualified as a reference under 35 U.S.C. § 103(a) by 35 U.S.C. §
    103(c)..." Examiner respectfully disagrees.  Applicant failed to clearly identify Burrows and Smith
    as being "commonly owned" by Microsoft at the time the later invention was made so as to
    preclude a rejection under 35 USC 102(e) in view of 35 USC 103(a).  See MPEP 706.02(l)(2) for
    information regarding establishing common ownership.


32. On July 24, 2004, an Oath and Declaration Statement was filed with the instant application,
    whereby Michael D. Smith and Stephen R. Walli are named inventors for instant application
    #10/788677.  While Michael Burrows, Martin Abadi, Mark Steven Manasse, Edward P. Wobber
    and Daniel Ron Simon are the named inventors for US Patent Application No US 2004/0093371
    A1.    Microsoft Corporation is the named assignee for both the instant application and the
    copending application.   MPEP Section 706.02(l) 2 Establishing Common Ownership or Joint

Research Agreement states: "...A statement of present common ownership is not sufficient *In Re Onada*, 229 USPQ 235 (Comm'r Pat. 1985)..." Furthermore, Per MPEP, Section 701 "...the fact that the reference and the application have the same assignee is <u>not</u> by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that common ownership was at the time the invention made. Moreover, applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the Examiner to be owned by, or subject to an obligation of assignment to the same person, at the time of the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time of the invention was made, owned by, or subject to an obligation of assignment to, the same person.

33. Applicant has failed to provide the required evidence to establish common ownership, therefore all of the limitations which Applicant disputes as missing in the applied references is fully disclosed or obvious in view of the collective teachings of Burrows and Huang. Burrows teaches a system and method for reducing spam and/or other unwanted behavior on a computer network. Huang discloses a personal email system that automatically and dynamically adjusts the protocols it uses to suit the particular provider site it is accessing. Detailed explanations are given in the preceding sections of the present Office Action

**Conclusion**

34. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Kimberly L. Evans whose telephone number is 571.270.3929. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, John Weiss can be reached at 571.272.6812.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to 571-273-8300. Hand delivered responses should be brought to the United States Patent and Trademark Office Customer Service Window: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629